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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,541	01/28/2004	David Robison	CRS / 275	3109
26875	7590	06/01/2006	EXAMINER	
WOOD, HERRON & EVANS, LLP			GRAY, LINDA LAMEY	
2700 CAREW TOWER			ART UNIT	PAPER NUMBER
441 VINE STREET				
CINCINNATI, OH 45202			1734	

DATE MAILED: 06/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/766,541	ROBISON ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Linda L. Gray	1734	

**~ The MAILING DATE of this communication appears on the cover sheet with the correspondence address ~**  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS,  
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

- 1) Responsive to communication(s) filed on 27 April 2006.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

- 4) Claim(s) 1-6 and 8-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 3-6 and 11 is/are allowed.
- 6) Claim(s) 1,2 and 8-10 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 1-28-04 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

**Detailed Action**

**Request for Continued Examination**

**1.** A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicants' submission filed on 4-27-06 has been entered.

**Claim Rejections - 35 USC 102**

**2.** The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**3. Claims 1-2 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Komarek et al. (US 5,466,211).**

**Claims 1 and 10,** Komarek et al. teach a method and apparatus including applying seam tape 27 onto sheet of membrane 14 wherein tape 27 includes a pressure sensitive adhesive strip and wherein tape 27 is applied to a center portion of membrane 14 by pressing a second surface of tape 27 against membrane 14. Then membrane 14 is cut into two separate sheets by cutting completely through membrane 14 and through tape 27 along a center portion of tape 27 forming continuous cut 18 completely separating membrane 14 to form two separate sheets of membrane 14 each having a continuous portion of tape 27 along one edge. Tape 27 is covered on a first surface with a release sheet. Specifically, see column 5, lines 41, to column 6, line 25; column 7, lines 20-56; and Figures 1, 5, and 7a. Specifically, tape 27 is applied before crushing (c 6, L 11-17) where crushing is performed using wedge 45 which also includes knife

wheel 37 having knife 48 for forming slit 18 (c 7, L 20-56); thus, tape 27 is applied prior to cutting.

With respect to the limitation in claim 1 of "adapted for use as a roofing membrane" and "roofing membrane", such refers to an intended use of the two sheets made using the claimed method and does not provide patentable subject matter to claim 1. The limitation does not further limit the steps of the claimed method. The same applies to claim 10 with respect to "adapted for use as a pond liner" and "pond liner".

**Claim 2,** tape 27 is applied to membrane 14 and membrane 14 is cut simultaneously since tape 27 is applied continuously using item 33 as membrane 14 passes thereunder while slit 18 is made.

**Claim Rejections - 35 USC 103**

**4. Claim 8 is rejected under 35 USC 103(a) as being unpatentable over Komarek et al.**

*Claim 8, Komarek et al. teach membrane 14 to be plastic (c 1, paras 3-4) but does not specifically recited EPDM.*

However, EPDM is a conventional material in the art of Komarek, and it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Komarek et al. that membrane 14 is EPDM as is conventional in the art for covering and protecting a honeycomb material thereunder when used for support and corner protectors.

**5. Claim 9 is rejected under 35 USC 103(a) as being unpatentable over Komarek et al. in view of Suominen (US 4,360,355).**

**Claim 9,** the above discussion of Komarek et al. applies herein.

*Claim 9, Komarek et al. teach that membrane 14 is guided through the apparatus but does not teach (a) guides including a plurality of disks located along a central axis of the apparatus. Komarek et al. teach that tape 27 is pressed at item 33 but does not teach (b) a contact roll per se. Komarek et al. teach supplying tape 27 but does not teach (c) a support roll of tape 27.*

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For (b) and (c) above, Suominen teaches a method including applying seam tape (from rollers 115a-e) onto sheet of membrane 111 wherein the tape includes a pressure sensitive adhesive strip wherein the tape is applied to at least a center portion of membrane 111 by pressing a second surface of the tape against membrane 111 and cutting membrane 111 into at least two separate sheets by cutting completely through membrane 111 along the center portion forming a continuous cut completely separating membrane 111 to form at least two separate sheets of membrane 111 each having a continuous edge (c 2, L 4-65). Suominen teaches that the tape also includes that the adhesive is covered on a first surface with release sheet 118 to prevent the adhesive from premature adhesion to other surfaces (c 4; L 22-29). There is provided a contact roll just after the tape application (Fig 2) to press the tape to membrane 111.

(A): Central guides under a moving membrane for support are conventional and for this reason it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided such in Komarek et al. for support thereunder

(B): It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Komarek et al. a contact roll for the pressing of tape 27 to membrane 14 taught by Komarek et al. because Suominen teach such to be a conventional apparatus to allow for sufficient pressing of a tape to a membrane in a taping apparatus.

(C): It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Komarek et al. a support roll for tape 27 because Suominen teach such to be a conventional apparatus to allow for continuous supply of a tape to a taping operation.

With respect to the claim limitation that the membrane is a roofing membrane, this limitation refers to the type of material operated upon by the claimed apparatus and does not provide a structural difference between claim 9 and the prior art.

**Allowable Subject Matter**

**5. Claim 3 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims.**

**Claims 4-6 and 11 are allowed.**

**6. The following is a statement of reasons for the indication of allowable subject matter:**

**claim 3:** cutting a membrane supported on a surface where the surface has a central groove aligned with the portion of membrane 14 to be cut is conventional in the art; however, Komarek et al. do not teach a seam tape applicator sheet slitter to be run along membrane 14 to apply tape 27 and cut membrane 14 in that in Komarek et al. modified membrane 14 is moved past a stationary apparatus for application of tape 27 and cutting slit 18;

**claim 4:** Komarek et al. in view of Suominen teach each limitation of claim 4 as discussed about but do not teach that the apparatus includes a handle providing means to push the apparatus over membrane 14 in that in Komarek et al. modified membrane 14 is moved past a stationary apparatus for application of tape 27 and cutting slit 18; and

**claim 11:** Komarek at al. in view of Liebmann teach each limitation of claim 11 but do not teach a seam tape applicator sheet slitter to be run along membrane 14 to apply tape 27 and cut membrane 14 in that in Komarek et al. modified membrane 14 is moved past a stationary apparatus for application of tape 27 and cutting slit 18.

**7. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements are specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP 707.07(a).**

**Response**

**8. Applicant's comments filed 4-27-06 have been fully considered. Claims 1 and 10, the Farrow reference is withdrawn in that Farrow does not teach cutting the membrane into two separate sheets by cutting completely though the membrane and tape and release sheet forming a continuous cut completely separating the membrane to form to**

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separate membranes in that Farrow intends to form a plurality of slits along the center of the membrane for the purpose of providing a 17"x22" sheet including a plurality (two or more) of shelf talkers which is economical in that the sheet is of a size that can be fed to a conventional printer for printing a plurality of shelf talkers simultaneously which are then manually separated. It would not have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Farrow otherwise thus taking away the economic improvement of the reference. Also, Farrow teach the liner to be of a width larger than the adhesive where the liner is then trimmed to size by simultaneously removing excess areas 21 and 22 at the printing press where modification of Farrow would eliminate this required step. The reasons for the allowance of claims 4-6, 9, and 11 over Farrow is presented in a previous Office action.

**Other Prior Art of Record**

**9.** The following prior art is made of record: Termaninin (US 5,474,634) applies tape, having a top release layer, to a cast and then cuts through the center of the tape and the cast thereunder.

**Conclusion**

**10.** Any inquiry concerning this communication or earlier communications from the examiner should be directed to Linda Gray whose telephone number is (571) 272-1228. The examiner can normally be reached Monday-Friday from 9:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla, can be reached at (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public Pair. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-1997 (toll-free).

llg  
May 30, 2006

*Linda Gray*  
LINDA GRAY  
PRIMARY EXAMINER